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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/541,391	03/31/2000	Rick Dedrick	042390.P7954	3488

7590

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EXAMINER

ABDI, KAMBIZ

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/541,391

**Applicant(s)**

DEDRICK ET AL.

**Examiner**

Kambiz Abdi

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language and the amended claims, and responses to previously presented claims and arguments based on such amendments.

- Claims 1-24 have been canceled.
- New claims 25-33 have been added.
- Claims 25-33 are pending.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 April 2004 has been entered.

### ***Claim Objections***

3. Claims 32 and 33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 32 and 33 are both dependent on claim 33.

### ***Response to Amendment***

4. Applicant's arguments with respect to claims 1, 3-6, 8-14, 16-22, and 24 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 25-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,189,146 to Pradyumna K. Misra in view of U.S. Patent No. 6,687,679 to Andrew Van Luchene et al.

As per claims 25, 28, and 31, Misra discloses a method, apparatus, and medium comprising:

- a network interface to obtain data associated with a volume license agreement (VLA) from a clearinghouse to transact a purchase of a software seat under the VLA in response to a user request to purchase the software (See Misra figures 1, 3 and 4 and associated text, column 2, lines 47-68, column 3, lines 59-68, column 4, lines 1-30, column 6, lines 50-68, and column 7, lines 1-11);
  - a database to store the obtained data, the data to include rules associated with the VLA, including rules on discount pricing, and a user profile associated with the requesting user (See Misra figures 1, 3 and 4 and associated text, column 2, lines 47-68, column 3, lines 59-68, column 4, lines 1-30, column 6, lines 50-68, and column 7, lines 1-11);
  - a repository to store information regarding a purchase history for the user for the software, including a number of software seats purchased under the VLA (See Misra tables 3 and 4, column 9, lines 29-61, column 4, lines 15-30, column 11, lines 25-45, and column 15, lines 19-36);
  - a user interface driver to receive the calculated current price and provide display information to a user interface to cause the user interface to display the current price (See Misra tables 3 and 4, column 9, lines 29-61, column 4, lines 15-30, column 9, lines 29-61, column 11, lines 25-45, and column 15, lines 19-36).
7. What is not clear by Misra, is the details of volume discount level (VLA) process.

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- a processor to access the stored VLA data, determine from the rules on discount pricing of the VLA data a discount step for the user requesting to purchase the software, determine from the stored purchase history information including the number of software seats purchased whether the discount step is current, update the discount step to reflect the determination of whether the discount price is current, and dynamically calculate a current price with the updated discount step, wherein to determine from the stored purchase history information whether the discount step is current includes the processor to determine if the software seat to be purchased will invoke a new discount step according to the rules on discount pricing, and if a new discount step will be invoked, determine what the new discount step will be, compare the new discount step to the discount step, and if the new discount step is different, update the discount step to be the new discount step (See Van Luchene abstract, figures 4-18 and associated text, column 2, lines 50-68, column 3, lines 1-34, column 4, lines 23-68, column 5, lines 1-53, column 7, lines 5-60, column 19, lines 39-68, and column 20, lines 1-33);

8. However, Van Luchene clearly teaches all the necessary steps of determination and update of a VLA discount rate within an automated system of purchasing of goods and services. Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to combine the teachings of the Misra with of Van Luchene to achieve a better accuracy and control of margins of profitability.

9. As per claims 26, 29, and 32, Misra and Van Luchene clearly disclose all the limitations of claim 25, 28, and 31, further;

Van Luchene clearly discloses the repository to store a purchase history comprising the repository to store information regarding the requested purchase to update the purchase history (See Van Luchene abstract, figures 2-4 and 11-13B and associated text). Therefore, it would have been obvious to one having ordinary skill in the art at the time the current invention was made to combine the two concepts to combine the teachings of the Misra with of Van Luchene to achieve a better accuracy and control of margins of profitability.

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10. As per claims 27, 30, and 33, Misra and Van Luchene clearly disclose all the limitations of claims 25, 28, and 31, further;

Misara clearly discloses a distribution engine to operate in conjunction with the network interface to automatically, remotely install the purchased software seat in response to the user purchase request (See Misra column 6, lines 20-45 and column 8, lines 35-52).

11. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

#### **Conclusion**

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Abdi whose telephone number is (703) 305-3364. The examiner can normally be

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reached on 9:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (703) 305-9768.

14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703)308-1113.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks  
Washington D.C. 20231**

or faxed to:

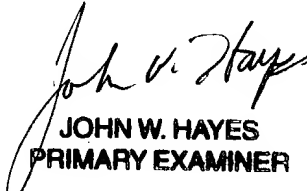
(703) 872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-7749 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to:

**Crystal Park 5, 2451 Crystal Drive  
7th floor receptionist, Arlington, VA, 22202**

**Abdi/K  
June 25, 2004**

  
**JOHN W. HAYES  
PRIMARY EXAMINER**